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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,475	04/20/2006	Sebastijan Bach	2003DE117	5841

25255 7590 08/30/2007
CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

MAIL DATE	DELIVERY MODE
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08/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,475	Applicant(s) BACH ET AL.	
	Examiner William K. Cheung	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>062707</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the amendment filed June 27, 2007, claim 8 has been cancelled.

Claims 1-7, 9-13 are pending.

2. In view of the argument filed June 27, 2007, the objection of claims 1, 10, 11 due to minor informalities is withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7, 9-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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In light of MPEP 2173.05(i), any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Since applicants' original disclosure does not have any basis for the negative limitation "at least one polyolefin wax is not polar modified" as claimed in claim 1, the rejection set forth under 35 U.S.C. 112, first paragraph is proper.

Since applicants' original disclosure does not have any basis for the negative limitation "the polyolefin waxes are not polar modified" as claimed in claim 10, the rejection set forth under 35 U.S.C. 112, first paragraph is proper.

Since applicants' original disclosure does not have any basis for the negative limitation "the polyolefin wax is not polar modified" as claimed in claim 11, the rejection set forth under 35 U.S.C. 112, first paragraph is proper.

5. In view of the amendment filed June 27, 2007, the rejection of Claims 1-5, 7-13 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hohner (US 5,998,547) is withdrawn. Further, the rejection Claim 6 under 35 U.S.C. 103(a) as obvious over Hohner (US 5,998,547), is withdrawn. However, in view of the 112 rejection set forth, the rejections in view of Hohner will be reinstated.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. Claims 1-5, 7, 9-13 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chang (US 4,914,253).

Chang (abstract) discloses composition comprising polyolefin (polyethylene) waxes prepared using metallocene catalysts. Chang (col. 1, line 64) discloses the use of said polyethylene waxes in hot melt adhesives. Because applicants' claim 1 recites a hot melt composition comprising between 0.1 and 100% by weight of at least one polyolefin wax, and in view of substantially identical material compositions disclosed in Chang and as claimed, and, the examiner has a reasonable basis to believe that the claimed dropping point or ring & ball softening point of between 80 and 165°C properties, melt viscosity, "measured at a temperature 10°C above the dropping or softening point" and the molecular weight properties are inherently possessed in Chang. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

9. Claims 1-7, 9-13 rejected under 35 U.S.C. 103(a) as obvious over Hohner (US 5,998,547) in view of Chang (US 4,914,253).

Hohner (col. 2, line 28-51) discloses composition comprising polyolefin waxes prepared using metallocene catalysts having the dropping point or ring & ball softening point and the melt viscosity properties that significantly overlap the dropping point or

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ring & ball softening point and the melt viscosity properties as claimed. Hohner (col. 8, claims 13-16) clearly claimed that disclosed composition as adhesives. In view of substantially identical material compositions, and dropping point or ring & ball softening point of between 80 and 165°C properties, the examiner has a reasonable basis to believe that the claimed "measured at a temperature 10°C above the dropping or softening point" and the molecular weight properties are inherently possessed in Hohner. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

The difference between Hohner and claims 1-7, 9-13 is that Hohner is silent on a composition comprising a polyolefin wax that has not been polar modified.

Chang (abstract) discloses composition comprising polyolefin (polyethylene) waxes prepared using metallocene catalysts. Chang (col. 1, line 64) discloses the use of said polyethylene waxes in hot melt adhesives. Motivated by the expectation of success of using the polyethylene waxes of Chang as viscosity modifiers (col. 1, line 61-65), it would have been obvious to one of ordinary skill in art to incorporate the polyethylene waxes of Chang into the Hohner to obtain the invention of claims 1-7, 9-13.

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Further, the difference between Hohner and claim 6 is that Hohner is silent on a composition comprising a polyolefin wax that has not been polar modified that is based on homopolymer of ethylene.

Chang (abstract) discloses composition comprising polyolefin (based on the homopolymer of ethylene) waxes prepared using metallocene catalysts. Chang (col. 1, line 64) discloses the use of said polyethylene waxes in hot melt adhesives. Motivated by the expectation of success of using the polyethylene waxes of Chang as viscosity modifiers (col. 1, line 61-65), it would have been obvious to one of ordinary skill in art to incorporate the polyethylene waxes of Chang into the Hohner to obtain the invention of claims 6.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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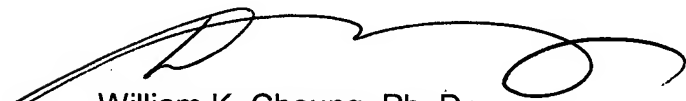
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William K. Cheung, Ph. D.

Primary Examiner

August 24, 2007

WILLIAM K. CHEUNG
PRIMARY EXAMINER